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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,735	11/17/2003	Robert Eugene Handfield JR.	PC23270A	4671
23913	7590	03/27/2007		
PFIZER INC 150 EAST 42ND STREET 5TH FLOOR - STOP 49 NEW YORK, NY 10017-5612			EXAMINER OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	
			MAIL DATE	DELIVERY MODE
			03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/714,735	Applicant(s) HANDFIELD ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see pages 2-5. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

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It is noted that applicants have filed an Amendment after the Final Rejection on 2/27/07; applicants' attorney has addressed the issues of record. The proposed amendment will be not entered due to a new issue that would require further consideration and search ; and , it is not in a condition for allowance.

The Status of Claims

Claims 1,3,5-17 are pending.

Claims 1,3,5-17 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of Claims 1, 3, 6-9, 11-13, 15-17 under 35 U.S.C. 102(b) as being anticipated clearly by Singer (US2003/0060624 A) will be withdrawn with the newly proposed amendment filed on 2/27/07.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of Claims 1,3,5-17 under 35 U.S.C. 103(a) as being unpatentable over Singer (US2003/0060624 A) has been maintained with the reasons of record on 3/21/06.

However, the newly proposed amendment raises a new issue that would require further consideration and search in the future office action; therefore, it will be not entered at this time of the prosecution of the application.

Applicants' Argument

Applicants argue the following issues:

- a. Singer does not exemplify the use of ammonium hydroxide in the example in addition to the specified and selected solvents in the proposed amendment ;therefore, the rejection of Claims 1, 3, 6-9, 11-13, 15-17 under 35 U.S.C. 102(b) as being anticipated clearly by Singer (US2003/0060624 A) will not be applicable.
- b. the mention of ammonium hydroxide and sodium t-oxide in the prior art is merely generic disclosure, but not the teaching of equivalence between them; therefore, there is no motivation to arrive at the current invention.

c. the distillation step is critical to controlling the stability, integrity, and purity of the product.

Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the first argument, the Examiner has noted applicants' arguments. With the proposed amendment, the rejection of Claims 1, 3, 6-9, 11-13, 15-17 under 35 U.S.C. 102(b) as being anticipated clearly by Singer (US2003/0060624 A) will be withdrawn in the future.

Second, regarding the second, and third arguments, the Examiner has noted applicants' arguments. However, regarding the use of ammonium hydroxide as a base in the example, the prior art does mention that the reaction with alkali or alkaline earth metal or ammonium hydroxide or carbonate is generally in an aqueous alcohol or tetrahydrofuran at a temperature from room temperature to 70⁰ C. (see col. 17, lines 8-12); the base can be selected from the group of sodium carbonate, sodium t-butoxide in a solvent such as tetrahydrofuran (see col. 11, paragraph #0129, lines 14-20). From these teachings, there is a teaching of equivalence between ammonium hydroxide and sodium t-butoxide as the base in the process. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to use ammonium hydroxide as an alternative base. This is because the skilled artisan in the art would expect such a modification to be feasible and successful as guidance shown in the prior art.

With respect to the removal of the solvent by the distillation, it is well-known in the art that the distillation process is a common practice in any organic synthesis. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to use the distillation process

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in the prior art process so as to remove the solvent in the reaction medium rapidly as possible .

This is because the skilled artisan in the art would expect such a manipulation to be feasible and successful since its application is well-known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taylor Victor Oh, MSD, LAC
Primary Examiner
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TAYLOR VICTOR OH
PRIMARY EXAMINER

3/20/07